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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/707,987	11/08/2000	John C. Myers	11559STUS02U	1024
27683	7590	12/28/2004	EXAMINER	
HAYNES AND BOONE, LLP 901 MAIN STREET, SUITE 3100 DALLAS, TX 75202			GAUTHIER, GERALD	
		ART UNIT	PAPER NUMBER	
		2645		

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/707,987	MYERS ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Gerald Gauthier	2645	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 26 August 2004.
- 2a) This action is **FINAL**.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 33-50 and 52-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 33-50,52,53 and 55 is/are rejected.
- 7) Claim(s) 54 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. **Claim 33** is rejected under 35 U.S.C. 102(e) as being anticipated by Ogle et al. (US 6,430,604 B1).

Regarding **claim 33**, Ogle discloses a method of accessing instant messaging on the data network (column 1, lines 7-18), comprising the steps of:

identifying a subscriber, a telephone number at which they can receive messages, and a predefined period of time for which they can receive messages at this number (column 8, lines 7-20) [The user 321 has registered with the system for alternatively receiving an instant message at a telephone number 325 between 9am-5pm 327 for certain days of the week];

establishing the user's presence and ability to receive instant messages on the data network during the specify time period (column 9, lines 34-42) [The instant messaging system 403 uses the user' s 311 entries that indicated that the user can be

reach by cellar telephone between 9 and 5 and sends the instant message to the user' s 311];

where an instant message is sent to the subscriber during this period of availability and calling the subscriber at the predetermined telephone number and delivering the message (column 9, lines 43-51) [The instant messaging system 403 converts the instant message through a text-to-speech, calls the user at the telephone number to deliver the message to the user 311 as a voice message using a commercial available voice synthesizer during 9 and 5 and inherently sending identifying the sender 401 to the receiver 311].

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. **Claims 34-42, 48, 50, 52-53 and 55** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle in view of Shah (US 2001/0013050 A1).

Regarding **claim 34**, Ogle discloses all the limitations of **claim 34** as stated in **claim 33**'s rejection and furthermore discloses presenting to the subscriber a subset of a predetermined user list, the subset representing users logged onto a data network (column 1, lines 34-49) [The instant messaging system typically indicates to the user the list of the people which are logon to the system].

Ogle discloses the user sending an instant message to a subscriber which has an available time for receiving the message but fails to disclose responsive to the subscriber selecting a particular user from the subset of the predetermined user list, sending a message from the subscriber to the selected data network user using an instant messaging protocol.

However, Shah teaches responsive to the subscriber selecting a particular user from the subset of the predetermined user list, sending a message from the subscriber to the selected data network user using an instant messaging protocol (¶ 0070) [The routing client 48 allows the sender to send a message to a selected recipient and in response to the sender selection of devices the routing client 48 proceeds to send the message to the respective receiving device].

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Ogle using the routing client as taught by Shah.

This modification of the invention enables the system to provide a unique identifier of each user so that the user would establish send the message via the receiver' s telephone.

Regarding **claim 35**, Ogle discloses the step of presenting occurs upon receipt of a predetermined command from the telephone user (column 1, lines 34-49).

Regarding **claims 36 and 40**, Ogle discloses the step of presenting including voice-synthesizing names of the user list (column 9, lines 43-51).

Regarding **claims 37 and 42**, Shah teaches the step of presenting includes playing back prerecorded names on the user list (¶ 0070).

Regarding **claims 38 and 41**, Shah teaches the step of presenting includes displaying names on the user list on a display associated with the telephone (¶ 0070).

Regarding **claim 39**, Ogle discloses the step of presenting occurs automatically upon login by the telephone user (column 1, lines 34-49).

Regarding **claim 48**, Ogle discloses the step of sending a message includes sending a prerecorded text message (column 9, lines 43-51).

Regarding **claim 50**, Ogle discloses the steps of receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message (column 10, lines 27-47).

Regarding **claim 52**, Ogle discloses the steps of, during the duration of time, receiving an instant message in response the message sent by the telephone user and notifying the telephone user of the receipt of the message at the telephone user's telephone number (column 9, lines 34-42).

Regarding **claim 53**, Ogle discloses the step of presenting includes the steps of first determining whether the telephone user is logged onto the data network and if not then presenting the user list (column 9, lines 60-65).

Regarding **claim 55**, Ogle discloses all the limitations of **claim 55** as stated in **claim 34**'s rejection and furthermore discloses determining whether the telephone user is logged onto a data network by determining if the telephone subscriber is a personal communications subscriber and if the user is, maintaining a presence in the data network for the telephone user for receiving and forwarding instant messages to the telephone user and if the telephone is not logged onto the data network, then presenting

the user list (column 9, lines 16-42) [The instant messaging system determines if the recipient is logged on in the system, if the recipient is logged on sends the instant message to the recipient and if the recipient is not logged on presenting the sender options or not sending the message or finding some alternative to send the message].

6. **Claims 43 and 45** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle in view of Shah and in further view of Ng et al. (US 6,424,647).

Regarding **claim 43**, Ogle and Shah as applied to **claim 34** differ from **claim 43**, in that it fails to disclose the step of selecting includes the step of receiving a DTMF command from the telephone user.

However, Ng teaches the step of selecting includes the step of receiving a DTMF command from the telephone user (column 18, lines 13-30).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Ogle using the DTMF decoder as taught by Ng.

This modification of the invention enables the system to provide a method for establishing a phone call over the Internet so that the user would dial the number for a phone call over the Internet.

Regarding **claim 45**, Ng teaches the step of selecting includes the step of receiving a proprietary signal from the telephone (column 18, lines 13-30).

7. **Claims 44, 46-47 and 49** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogle in view of Shah and in further view of Sekiguchi et al. (US 5,848,134).

Regarding **claim 44**, Ogle and Shah as applied to **claim 34** differ from **claim 44**, in that it fails to disclose the step of selecting includes the step of receiving a voice command from the telephone user.

However, Sekiguchi teaches the step of selecting includes the step of receiving a voice command from the telephone user (column 11, lines 63-67).

It would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify Ogle using the vice data format as taught by Sekiguchi.

This modification of the invention enables the system to provide a real-time message exchange between a telephone and a computer so that the user would send messages between terminals of different types.

Regarding **claim 46**, Sekiguchi teaches the step of sending a message includes recording and sending a voice message (column 11, lines 63-67).

Regarding **claim 47**, Sekiguchi teaches the step of sending a message includes sending a prerecorded voice message (column 11, lines 63-67).

Regarding **claim 49**, Sekiguchi teaches the step of sending a message includes sending a text transcription of a voice message (column 13, lines 11-14).

***Allowable Subject Matter***

8. **Claim 54** is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Regarding **claim 54**, the prior art at this time fails to disclose the step of determining whether the telephone user is logged onto the data network includes determining if the telephone subscriber is a personal communications subscriber and, if the user is, maintaining a presence in the data network for the telephone user for receiving and forwarding instant messages to the telephone user.

***Response to Arguments***

9. Applicant's arguments with respect to **claims 33-35, 39, 43-50, 52-53 and 55** have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

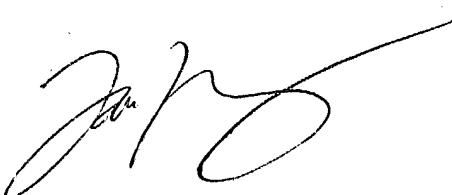
10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (703) 305-0981. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**GERALD GAUTHIER**  
**PATENT EXAMINER**

g.g.  
December 16, 2004



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